

Serial N . 09/915,060

REMARKS

The Final Office Action of August 12, 2003, has been received and reviewed. Claims 4, 11-15, 23-25 and 27-40 are pending in the application and all pending claims stand rejected. Applicants propose to amend claims 4, 11, 12, 14, 25, 27, 28, 30 and 37-40 as set forth herein. All amendments are made without prejudice or disclaimer. Reconsideration is respectfully requested.

Rejections under 35 U.S.C. § 102**Claims 4, 11, 12 and 37-40**

Claims 4, 11, 12 and 37-40 stand rejected under 35 U.S.C. § 102(b) as assertedly being anticipated by Xiang et al. Applicants respectfully traverse the rejections as set forth herein.

Specifically, it was thought that "any claim to a nucleic acid which is only limited to comprising the sequences set forth as SEQ ID NO: 1 or 4-7 still encompass the nucleic acids disclosed [in the cited references]." (Final Office Action mailed August 12, 2003, page 4). Although applicants do not agree that claims 4, 11, 12 and 37-40 are anticipated, to expedite prosecution, applicants propose to amend independent claims 4 and 37 in accordance with the suggestion of the Examiner to include the phrase "consisting of." (*Id.* at page 3). Thus, independent claim 4, claim 40 depending therefrom, independent claim 37 and claims 11, 12 and 38-89 depending therefrom, should not be anticipated.

Reconsideration and withdrawal of the anticipation rejections of claims 4, 11, 12 and 37-40 are requested.

Claims 25, 27-36 and 37-39

Claims 25, 27-36 and 37-39 stand rejected under 35 U.S.C. § 102(a) as assertedly being anticipated by Gururajan et al. Applicants respectfully traverse the rejections as set forth herein.

It was thought "because the claims are again directed to nucleic acids comprising (the Office allegedly interprets the phrase "consisting essentially of" as open with regard to nucleic acid sequences) the fragments having defined function, the claims read on any nucleic acid, such as the nucleic acids taught by Gururajan et al., which comprise the sequence disclosed in the

Serial No. 09/915,060

instant application." (Office Action of February 24, 2003, page 4). Although applicants do not agree that claims 25, 27-36 and 37-39 are anticipated or that the proper standard is being applied; for the sake of expedited prosecution, applicants propose to remove the term "essentially" from independent claim 25 and to amend independent claim 37 to recite in part "a recombinant nucleic acid molecule consisting of SEQ ID NO:1, 4-6 or 7."

Thus, since independent claims 25 and 37 use the transitional phrase "consisting of" in accordance with the suggestion of the Examiner, claims 25, 27-36 and 37-39 should not be anticipated. Reconsideration and withdrawal of the anticipation rejections of claims 25, 27-36 and 37-39 are requested.

Rejections under 35 U.S.C. § 103

Claims 13-15, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as assertedly being obvious over Xiang et al. Applicants respectfully traverse the rejections as set forth herein.

Claims 13-15, 23 and 24 all depend, directly or indirectly from claim 37. Accordingly, these claims should be non-obvious as depending, directly or indirectly, from non-obvious independent claim 37. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (*See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, reconsideration and withdrawal of the obviousness rejections of claims 13-15, 23 and 24 are requested.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 4, 11-15, 23-25 and 27-40 stand rejected under 35 U.S.C. § 112, second paragraph, as assertedly being indefinite. Applicants respectfully traverse the rejections as hereinafter set forth.

Claims 4, 25 and 37 were thought to be indefinite for use of the term "heterologous." It was thought that the term "heterologous" was relative and that it's meaning depended on what the nucleic acid was compared to. (*See, Final Office Action* at page 5). Although applicants do not agree that the claims are indefinite or that the term is misunderstood, for the sake of expedited prosecution, applicants propose to amend independent claims 4, 25 and 37 in

Serial N . 09/915,060

accordance with the suggestion of the Examiner wherein the term "heterologous" is replaced with the term "chimeric." Applicants further propose to amend the claims depending from independent claims 4, 25 and 37 in accordance with the term "chimeric" in the independent claims.

Claims 27-35 were further thought to be indefinite for being directed to genes, vectors and cells comprising the "nucleic acid sequence of claim 25." (*See, Id.*). Specifically, it was thought to be unclear "whether applicant intends that the products of the dependent claims comprise only those sequences set forth as SEQ ID NO: 4, 5, and 6 or the entire nucleic acid molecule of claim 10." (*Id.*): In accordance with the suggestions of the Examiner, applicants propose to amend the relevant portions of claims 27-35 to recite "molecule" in place of "sequence."

Accordingly, reconsideration and withdrawal of the indefiniteness rejections of claims 4, 11-15, 23-25 and 27-40 are requested.

ENTRY OF AMENDMENTS

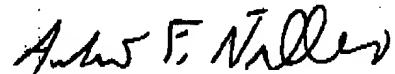
The proposed amendments to claims 4, 11, 12, 14, 25, 27, 28, 30 and 37-40 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. The amendments should place the application in condition for allowance since they adopt suggestions of the Examiner. Finally, if the Examiner determines that the proposed amendments do not place the application in condition for allowance, entry is respectfully requested since they certainly remove issues for appeal.

Serial N . 09/915,060

CONCLUSION

In view of the proposed amendments and remarks, applicants respectfully submit that the amended claims define patentable subject matter. If questions should remain after consideration of the foregoing, the Examiner is kindly requested to contact applicants' attorney at the address or telephone number given herein.

Respectfully submitted,



Andrew F. Nilles
Registration No. 47,825
Attorney for Applicants
TRASKBRITT, PC
P.O. Box 2550
Salt Lake City, Utah 84110-2550
Telephone: 801-532-1922

Date: October 7, 2003

AFN

Document in ProLaw

**RECEIVED
CENTRAL FAX CENTER**

OCT 08 2003

OFFICIAL